



### Melinda Upton

Partner

GLOBAL CO-CHAIR, INTELLECTUAL PROPERTY & TECHNOLOGY

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Melinda Upton is a leading intellectual property partner with extensive experience across all aspects of brand protection, exploitation and enforcement, both in Australia and globally. This includes advising local, regional and global companies on branding and rebranding strategies and maximising their intellectual property portfolios, as well as matters involving trademark protection and enforcement, anti-counterfeiting, advertising and marketing, domain name disputes, consumer protection, passing off, social media and design protection, plus intellectual property audits and due diligence.

Melinda has acted for domestic and global clients (including public, private and government entities) across a number of industries including FMCG, energy, water management, entertainment, life sciences, technology, cosmetics, healthcare, aviation, transport, financial services, energy and resources, publishing, fashion and hospitality.

She has worked side by side with corporate, financial services and insolvency colleagues on transactions involving significant IP assets in the Asia, North American and European regions. She has also worked with investigators and prosecuting authorities on criminal investigations and with the Australian Customs Service to prevent the importation of counterfeit goods in Australia.

Another area of focus for Melinda is corporate rebranding. To deliver maximum value in these projects, Melinda and her team become involved in the early concept stages, working with various stakeholders and assisting with searches to assess availability in Australia and other countries; presenting to brand teams and advertising agencies, advising on registrability of marks, carrying out registration of the chosen trademarks, domain names and business names, and assisting with launch materials, including review of marketing and advertising materials and developing brand guidelines and IP policies.

Melinda regularly presents on protecting and maximising the value of brands, addressing issues such as trademark protection and enforcement, IP policy, corporate branding and rebranding strategies, marketing and advertising, social media, green marketing and other intellectual property issues. She has also acted extensively for a number of pro bono clients.

#### RELATED SERVICES

- Intellectual Property and Technology
- Technology Transactions and Strategic Sourcing

#### RELATED SECTORS

- Life Sciences

#### EXPERIENCE

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## Trademarks, copyright, internet, advertising and marketing

- Acting for one of the world's top pharmaceutical companies and lead partner in relation to the management of its trade mark portfolio in Australia and Papua New Guinea
- Advising local and global FS clients with a full suite of IP services including trademark registrations, domain name and infringement issues, negotiation of co-existence agreements and advising on marketing and advertising issues
- Managing the global trademark portfolio for a large Australian investment and trustee group and assisting the client with the enforcement of its IP rights including cybersquatting matters
- Providing IP advice to a large water management company as part of a corporate rebranding strategy. This work included: conducting clearance and registrability searches for the new brand; preparing an infringement risk assessment and advising on strategy; providing advice in relation to the new brand guidelines and brand extension issues
- Representing Asia's leading agribusiness group in non-use removal proceedings and advising on trade mark protection issues
- Advising one of Australia's largest FMCG companies regarding its policies and approach to intellectual property rights management, including intellectual property issues associated with product launches, food labelling, corporate rebranding strategies and the protection and enforcement of the company's trade mark portfolio (over 2,000 trademarks worldwide)
- Advising various fashion and apparel clients including a Japanese based company engaged in the operation of a social networking service on branding, labelling, country of origin issues, parallel importation, trade mark and domain name registration and enforcement matters in Australia
- Advising on the importation, sale and distribution of products in Australia in contravention of the Competition and Consumer Act 2010 (Cth) and passing off
- Advising on anti-counterfeiting measures including putting in place customs watch notices in Australia and coordinating educational campaigns with Australian Customs. Drafting and negotiating a number of trademark licence, co-existence, and assignment and settlement agreements
- Acting for a publishing company concerning the unauthorised third party use of one of its well-known brand names. The matter involved trademark, domain name and business name aspects. Federal Court proceedings were commenced, but a desirable negotiated outcome was achieved for the client prior to the hearing, whereby the third party ceased all use of the particular brand name

## Corporate transactions

- Representing a consortium led by one of Japan's largest general trading companies on its acquisition of the Australian subsidiary of a UK listed company
- Advising on the IP aspects in relation to the acquisition by a Chinese state owned enterprise (SOE) of a large Australian sugar and renewable energy business. From an IP perspective, the matter involved a number of IP searches in Australia and other countries including France, Brazil, Thailand and the USA, reviewing the IP documents and drafting the IP sections of the due diligence and transaction documents. Had this transaction completed, it would have represented China's largest non-resources investment in Australia

## CREDENTIALS

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### Professional Qualifications

- Solicitor of the High Court of Australia, 2002
- Solicitor of the Supreme Court of New South Wales, 2002

### Recognitions

Melinda is commended in the *WTR 1000: The World's Leading Trademark Professionals 2018* as a leading individual for prosecution and strategy.

Melinda has been listed as a recommended lawyer in Intellectual Property in the World Trademark Review since 2011, with clients stating that '*she has the appetite to invest the time and energy in her clients. Many IP lawyers seem to leave it to the business to*

*decide what it needs, but not her – she is client focused and commercially oriented.'*

Commentators brand her as a '*highly efficient and active partner with strong client skills*' and '*extremely capable and astute*'. From 2009, Melinda has been listed as a 'recommended lawyer' in the Intellectual Property category of Legal 500 Asia-Pacific and described as delivering '*a practical and complete answer which doesn't require extensive research and unnecessary expense.*'

Most recently, Melinda has been recognised as a leading female intellectual property practitioner in the 2018 edition of *Managing Intellectual Property's Top 250 Women in IP*. This special publication recognises female practitioners in private practice who have performed exceptionally for their clients and firms in the past year.

In *Managing IP Stars*, Melinda is recognised as a Trademark Star and in 2018 is described as '*highly recommended for complex trademark protection issues in Australia and New Zealand*' and in 2017 '*Melinda is a clear market leader*'.

She is also a notable practitioner (band 4) *Chambers & Partners Asia-Pacific Trademark & Copyright* 2018 and has been listed in *Best Lawyers* for Intellectual Property Law since 2016.

## Memberships

- Member of Intellectual Property Society of Australia and New Zealand and previously served on NSW Committee
- Member of International Trade Mark Association (INTA) and recently appointed to its parallel imports committee
- Registered Notary Public and member of Society of Notaries of New South Wales
- Member, Australian Institute of Company Directors

## Notary

Melinda is a registered Public Notary.

## INSIGHTS

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Melinda has in recent years worked with Kluwer Law International to publish a chapter in the online service *Kluwer Manual IP*. The chapter looked at the trademark and patent registration systems in Papua New Guinea. She regularly presents on protecting and maximising the value of IP, including topics such as trade mark protection and enforcement, IP policy, corporate branding and rebranding strategies, anti-counterfeiting strategies, marketing and advertising, social media, green marketing and other IP issues. Melinda is frequently asked by the media to comment on emerging issues in IP.

## Publications

### **Subscribed, sealed, delivered: The rise of the subscription box retail model**

16 December 2019

By paying a regular fee, subscribers receive a recurring delivery of products, often picked at random for the customer by the supplier. The convenience of these boxes appearing on the doorstep, coupled with the "reward uncertainty" for what might be in the box, can be a powerful strategy for keeping consumers engaged with brands.

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### **Therapeutic Goods Administration cracks down on prohibited advertising**

3 October 2019

A series of recent enforcement actions and announcements by the Therapeutic Goods Administration (**TGA**) indicate that the regulator is actively monitoring and prosecuting businesses for breaches of the *Therapeutic Goods Advertising Code (No. 2) 2018 (TG Advertising Code)* and *Therapeutic Goods Act 1989 (TG Act)*.

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## **Don't get caught out: Intellectual property arrangements will be susceptible to prosecution for anti-competitive conduct from 13 September 2019**

12 September 2019

From 13 September 2019, commercial arrangements relating to IP rights - including licences, assignments, litigation settlement agreements and other contracts, arrangements or understandings between businesses - will no longer be exempt from the anti-competitive conduct provisions of the Competition and Consumer Act 2010 (Cth) (CCA).

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## **Vigilance required: Trademark exhaustion and parallel importation in Australia**

20 MAY 2019

Maintaining the integrity of distribution channels is a key concern for brand owners, particularly in the fashion and luxury goods industries.

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## **Sound identities: Back in vogue for corporate rebranding and brand refreshes**

15 MAY 2019

Businesses are constantly looking for an extra dimension that will allow their brand to cut through the saturation of the modern world. Increasingly, corporate re-brands or brand refreshes are including bespoke musical themes known as 'sound identities' or 'audio brands' to create a further aural association with the product or service offering.

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## **Given the treatment: The Therapeutic Goods Advertising Code 2018**

8 MAR 2019

Late last year, the *Therapeutic Goods Advertising Code (No. 2) 2018* (**New TGA Code**) was enacted as the code that regulates advertising of therapeutic goods to consumers in Australia. Read our summary of the regulatory framework for the advertising of therapeutic goods in Australia, key changes under the New TGA Code that came into effect on 1 January 2019 and penalties for non-compliance.

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## **Five ways to proactively develop and protect your brand in Australia**

21 FEB 2019

Inadvertent infringement or issues with registering a core trademark have the potential to stall the growth trajectory of a business. In this article, we look at five ways to proactively develop and protect a brand in the Australian market.

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## **The rising star of the social media influencer**

26 NOV 2018

Traditionally, fashion and luxury brands have promoted their products using celebrity or sporting endorsements on media including television, print and publically displayed advertisements. However, the dawn of social media has dramatically transformed marketing and advertising campaigns, which are now often built around social media platforms and individuals with extensive online followings, known as influencers.

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- Sound identities: Back in vogue for corporate rebranding and brand refreshes, 15 May 2019
- Given the treatment: The Therapeutic Goods Advertising Code 2018, 8 March 2019
- Five ways to proactively develop and protect your brand in Australia, 21 February 2019
- New tools of the trade (mark) - changes to the parallel importation defence, unjustified threats and trade mark prosecution procedure, 3 October 2018
- Regular contributor to Retail Thera IP blog, providing Australian legal advertising and marketing updates

## Events

Melinda regularly presents on protecting and maximising the value of IP, including topics such as trade mark protection and enforcement, IP policy, corporate branding and rebranding strategies, anti-counterfeiting strategies, marketing and advertising, social media, green marketing and other IP issues. Melinda is frequently asked by the media to comment on emerging issues in IP.

## NEWS

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### **DLA Piper boosts projects capability with partner hire in Australia**

16 APR 2019

DLA Piper has strengthened its Finance and Projects practice with the appointment of senior projects lawyer Tom Fotheringham as partner in its Brisbane office.

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### **DLA Piper recognised as Employer of Choice for Gender Equality in Australia**

25 FEB 2019

DLA Piper has again been awarded the Employer of Choice for Gender Equality citation by the Australian Government's Workplace Gender Equality Agency (WGEA).

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### **29 DLA Piper lawyers in 10 countries ranked among *The World's Leading Trademark Professionals***

12 FEB 2019

*WTR 1000: The World's Leading Trademark Professionals 2018* has named 29 DLA Piper lawyers from nine countries to its list of top trademark professionals.

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### **DLA Piper advises fintech company Splitit on its IPO**

31 Jan 2019

DLA Piper advised global payment installment solution company Splitit Payments Ltd on its Australian Stock Exchange initial public offering this week.

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### **DLA Piper promotes first Australians to international management roles and announces new Australian country MP**

6 Dec 2018

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As part of an international executive revamp DLA Piper Australia co-managing partners Melinda Upton and Jim Holding will be taking on International management responsibilities in a significant endorsement of Australia's performance within the firm.

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### **DLA Piper sees flurry of fintech activity in 2018**

13 December 2018

The Australian fintech industry is set for strong growth in 2019 and 2020 according to DLA Piper as Data Republic – advised by DLA Piper - joins a trend of local fintech's undertaking successful venture capital backed funding rounds in 2018.

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